

(33) Please add new Claim 69 as follows:

1 ~~334~~ 69. The method as recited in claim ~~48~~ 49, wherein the activation signal is initiated by the  
2 user while the user is listening to the voice mail message while the voice mail message is being  
3 recorded into the user's mailbox by a caller.

(34) Please add new Claim 70 as follows:

1 ~~49~~ 70. The system as recited in claim ~~66~~ 40, wherein the monitoring of the voice mail  
2 message while the message is being recorded into the user's mailbox occurs while the telephone  
3 is off-hook.

#### REMARKS

Claims 1-68 are pending in the Application.

Claims 1-68 stand rejected.

Claims 22, 38, 39, 43, 46, 47, and 61 are hereby canceled.

New Claims 69 and 70 are hereby added.

#### I. REJECTION UNDER SPECIFICATION

Applicants have updated the related patent application cited on page 1.

#### II. REJECTION UNDER 35 U.S.C. § 112

The Examiner has rejected claims 18-21, 32-47, 61-62 and 65 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In response, Applicants respectfully traverse this rejection.

More specifically, with respect to claim 18, the Examiner asserts that the phrase "circuitry for recording all or a portion of the call" is unclear as to what "all of the call" refers to. In

response, Applicants have amended claim 18 to recite that what is recorded is the call after the telecommunications device is connected to the call. This should clarify that the recording circuitry does not record the ringing signals of the call.

With respect to claim 32, the Examiner asserts that it is uncertain which element of the Specification is referred to by the claimed apparatus. In response, Applicants have amended claim 32 so that this set of claims now recites that it is a "system" instead of an "apparatus". The Examiner has further asserted that the phrase "without having to call a resource" is confusing because it is not clear if this phrase describes the apparatus or the telephone extension. Applicants have amended claim 32 to recite that it is the user of the telephone extension that does not have to call a resource. The Examiner further asserts that it is uncertain which elements of the Specification are referred to by the claimed "downloading the information" and "playing portions of the information." In response, Applicants respectfully assert that there are several portions of the system that come into play in performing these operations, such as the microprocessor and the DSP. This is further shown in Figures 7A-7D which are discussed in the Specification from page 25, line 13 through page 29, line 24.

The Examiner has also rejected claim 40 for the same reasons, and thus Applicants' response above applies as well. The Examiner has further asserted that it is not clear as to why only portions of the downloaded information are played. Such portions are a result of the user being able to press different keys on the phone to listen to different parts of the information, as exemplified by the various options provided in Figures 7A-7D.

With respect to claim 61, the Examiner has asserted that it is uncertain which element of the Specification is referred to by the claimed "voice signal originated from a voice mail message." In response, Applicants have canceled claim 61.

The Examiner asserts that "the tactilely initiated activating signal" in claim 62 lacks antecedent basis. Applicants have amended claim 62 to overcome this problem.



### III. REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-6, 8-10, 12-21, 23-31, and 58-68 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Sakurai et al.* (U.S. Patent No. 5,586,172). In response, Applicants respectfully traverse this rejection. As the Examiner is well aware, for a claim to be anticipated under § 102, each and every element of the claim must be found within the cited prior art reference.

Claim 1 has been amended to incorporate the limitations of claim 22. Amended claim 1 will be addressed by Applicants below with respect to the § 102 rejection of claim 22. In view of the amendment of claim 1 with the limitations of claim 22, the § 102 rejection of claims 1-2, 18-20, 24-25, and 30 are moot.

Claim 3 has been amended to incorporate the limitations of claims 1 and 2 so as to be in independent form. In rejecting claim 3 as being anticipated by *Sakurai* under § 102, the Examiner has not addressed the specific claim limitations of claim 3 in any way. More specifically, the Examiner has not shown where in *Sakurai* it is taught that the switching circuitry comprises a digital cross-point matrix coupled to the single processing means and to the signal processing circuitry. These limitations are not taught by *Sakurai*. As a result, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of anticipation in rejecting claim 3.

Furthermore, the specific limitations recited within claims 4-6, 8-10, 12-17, 21, 23, 27-31, 59-65, and 67-68 have not in any way been specifically addressed by the Examiner. For this reason alone, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of anticipation in rejecting these claims.

*Sakurai* does not teach a codec adaptable for receiving a call from a CO, the first codec coupled to the digital cross-point matrix, as specifically recited within claim 4. *Sakurai* does not teach circuitry, coupled to the digital cross-point matrix, adaptable for coupling the call to an extension telephone, as specifically recited within claim 5. *Sakurai* does not teach that the

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single processing means is controlled by a single set of software operable for controlling both the switching circuitry and the voice processing circuitry, as specifically recited within claim 6.

*Sakurai* does not teach that the voice processing circuitry includes circuitry for playing stored sound or data to the call, as specifically recited within claim 8. *Sakurai* does not teach that the circuitry for playing stored sound or data to the call further includes a codec coupled to the digital cross-point matrix, a transformer coupled to the codec, and an analog sound source coupled to the transformer, as specifically recited within claim 9. *Sakurai* does not teach that the circuitry for playing stored sound or data to the call further includes digitized stored sound or data stored in a hard disk coupled to the single processing means, circuitry for transferring the digitized stored sound or data from the hard disk to a play buffer in the signal processing circuitry, and circuitry for transferring the digitized stored sound or data from the play buffer to the call, as specifically recited within claim 10. *Sakurai* does not teach that the signal processing circuitry further includes a DTMF receiver operable for recognizing DTMF tones from the call, as specifically recited within claim 12. *Sakurai* does not teach that the signal processing circuitry further includes a recording buffer operable for recording the call, as specifically recited within claim 13. *Sakurai* does not teach that the signal processing circuitry further includes a fax tone detector operable for recognizing fax signals from the call, as specifically recited within claim 14. *Sakurai* does not teach that the signal processing circuitry further includes a caller-id modem operable for recognizing caller-id signals from the call, as specifically recited with claim 15. *Sakurai* does not teach that the signal processing circuitry further includes a call processing tone generator operable for generating and transmitting to the call standard call processing tones, as specifically recited within claim 16. *Sakurai* does not teach that the signal processing circuitry further includes a conference bridge operable for coupling the call to one or more internal or external telecommunications devices, as specifically recited within claim 17. *Sakurai* does not teach that the tactilely initiated activating signal is produced when a user presses a record button on an extension telephone coupled to the system, as specifically recited

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within claim 21. *Sakurai* does not teach that the system recited in claim 3 further comprises a play channel in the signal processing circuitry for playing a message to the caller, wherein the message is downloaded from a memory coupled to the single processing means, a DTMF receiver in the signal processing circuitry for receiving DTMF tones sent from the call, and circuitry for connecting the call to the telecommunications device in response to the DTMF tones, as specifically recited within claim 23. *Sakurai* does not teach that the voice signal specifically recited in claim 25 originated from a voice mail message stored in the system, as specifically recited within claim 27. *Sakurai* does not teach that the tactilely initiated activating signal recited in claim 25 is produced when the user presses a record button on the telephone extension coupled to the system, as specifically recited within claim 28. *Sakurai* does not teach circuitry for storing time and date of call, and caller-id information associated with the call, as specifically recited within claim 29. *Sakurai* does not teach that the recording of the call can be activated any time while the call is coupled to the telephone extension, as specifically recited within claim 30. *Sakurai* does not teach circuitry for deactivating the recording of the call in response to a pressing of the record button by the user, as specifically recited within claim 31. *Sakurai* does not teach that the activating step recited in claim 58 is tactilely initiated by a user of the telephone extension, as specifically recited within claim 59. *Sakurai* does not teach that the tactilely initiated activating step recited in claim 59 is produced when a user presses a record button on the telephone extension coupled to the system, as specifically recited within claim 62. *Sakurai* does not teach the step of storing time and date of call, and caller-id information associated with the call, as specifically recited within claim 63. *Sakurai* does not teach the recording of the call can be activated any time while the call is coupled to the telephone extension, as specifically recited within claim 64. *Sakurai* does not teach the deactivating of the recording of the call in response to a pressing of the record button by the user, as specifically recited within claim 65.

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As a result, these claims are not anticipated by *Sakurai*. The Examiner is respectfully reminded that it is the Examiner's responsibility to address each and every limitation of a claim, and to present a *prima facie* case of anticipation for each and every claim within the Application. Otherwise, the claims are allowable over the cited prior art.

With respect to claim 66, the Examiner asserts that *Sakurai* teaches that the user can monitor the message that is generated from the other side of the call and is recorded by the recording means. Applicants respectfully traverse this assertion. Claim 66 specifically recites that the user of a telephone is permitted to monitor the voice mail message while the message is being recorded into the user's mailbox. This is not taught within *Sakurai*. *Sakurai* merely teaches that an incoming call can be recorded into a voice memory 21. However, the voice memory 21 is not to be equated with the user's voice mailbox.

The Examiner has rejected claims 32-47 under 35 U.S.C. § 102(e) as being anticipated by *Ohtsuka* (U.S. Patent No. 5,815,552). In response, Applicants respectfully traverse this rejection. Claim 32 has been amended to incorporate the limitations of claims 35, 38, and 39, while claim 40 has been amended to incorporate the limitations of claims 43, 46, and 47. Since the Examiner has not in any way specifically addressed the claim limitations recited within claims 35, 38, 39, 43, 46 and 47, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of anticipation in rejecting these claims. Furthermore, *Ohtsuka* does not teach that the activation signal recited in claim 32 is tactilely initiated by the user of the telephone extension, circuitry for receiving another signal tactilely initiated by the user of the telephone extension, wherein this another signal includes coding indicating a content of the information, and circuitry for retrieving the information having the content from the memory and providing it to the play channel, wherein the signals are activated by the user while the telephone extension is connected to a call, as specifically recited within claims 32 and 40.

The Examiner has rejected claims 40-47 under 35 U.S.C. § 102(e) as being anticipated by *Petty* (U.S. Patent No. 5,623,538). In response, Applicants respectfully traverse this rejection.

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Again, the Examiner has not in any way addressed the specific limitations recited within claims 43, 46, and 47. Therefore, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of anticipation in rejecting these claims. Further, *Petty* does not teach that the activation signal is tactilely initiated by the user of the telephone extension, the step of receiving another signal tactilely initiated by the user of the telephone extension, wherein this signal includes coding indicating a content of the information, and the step of retrieving the information having the content from the memory and providing it to the play channel, wherein the signals are activated by the user while the telephone extension is connected to a call, as specifically recited within amended claim 40.

The Examiner has rejected claims 1 and 48-57 under 35 U.S.C. § 102(b) as being anticipated by *Matthews et al.* (U.S. Patent No. 4,602,129). In response, Applicants respectfully traverse this rejection.

As noted above, claim 1 has been amended to incorporate the limitations of claim 22. Therefore, the § 102 rejection of claim 1 as being anticipated by *Matthews* is moot.

With respect to claim 48, *Matthews* does not teach or suggest the step of prompting the user to enter a second signal from a second of a plurality of mailboxes to receive a copy of the message. As a result, Applicants respectfully assert that claim 48 is not anticipated by *Matthews*.

With respect to claim 50, the Examiner has not addressed the specifically recited limitation of the activation signal being initiated by the user while the user is listening to the voice mail message. As a result, the Examiner has failed to prove a *prima facie* case of anticipation in rejecting this claim. This specific recitation in claim 50 is not anticipated by *Matthews*.

For the same reasons as given above with respect to claims 48-52, claims 53-57 are also not anticipated by *Matthews*.

Claims 58-65 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *D'Agosto* (U.S. Patent No. 4,860,339). In response, Applicants respectfully traverse this rejection. With

respect to claim 58, the Examiner has asserted that the preamble is not given any patentable weight because the body of the claim does not depend upon the preamble for completeness. Applicants respectfully traverse this assertion. Line 7 of claim 58 specifically recites the step of listening to a voice signal at a telephone extension coupled to the system. Quite clearly, this listening step depends upon the system specifically recited within lines 1-6 of claim 58. As a result, the Examiner is to give the entire preamble patentable weight, because it describes the system in which at least one step in the method relies upon.

The Examiner has further asserted that the single processing means is taught by microprocessor 70, and that the voice processing means is taught by device 51. Applicants respectfully traverse the Examiner's assertion because claim 58 specifically recites that the switching circuitry and the voice processing circuitry are controlled by a single processing means. In no way does microprocessor 70 control elements 51. Bus 72 is not shown in any way to be connected to device 51. Therefore, *D'Agosto* does not teach that the voice processing circuitry is controlled by the microprocessor.

With respect to claims 59-65, the Examiner has not addressed the specific limitations in any form. As a result, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case that *D'Agosto* anticipates claims 59-65. Further, *D'Agosto* does not teach that the activating step is tactilely initiated by a user of the telephone extension, as specifically recited within claim 59. *D'Agosto* does not teach that the tactilely initiated activating step is initiated when a user presses a record button on the telephone extension coupled to the system, as specifically recited within claim 62. *D'Agosto* does not teach the step of storing time and date of call, and caller-id information associated with the call, as specifically recited within claim 63. *D'Agosto* does not teach the recording of the call can be activated any time while the call is coupled to the telephone extension, as specifically recited within claim 64. *D'Agosto* does not teach the step of deactivating the recording of the call in response to a pressing of the record button by the user, as specifically recited within claim 65.

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IV. REJECTION UNDER 35 U.S.C. § 103

The Examiner has rejected claims 7 and 11 under 35 U.S.C. § 103 as being unpatentable over *Sakurai* in view of *O'Malley* (U.S. Patent No. 4,996,707). In response, Applicants respectfully traverse this rejection. The Examiner admits that *Sakurai* does not teach that the communication device is a fax machine or a modem. The Examiner, though, states that it is well known in the art that an extension line of a subscriber can be connected to a fax machine or a modem, and that *O'Malley* discloses the extension line of a subscriber connected to a fax machine or modem. Applicants respectfully traverse this rejection by the Examiner, because claim 7 specifically recites that the switching circuitry comprises a digital cross-point matrix coupled to the single processing means and the signal processing circuitry, and that the facsimile machine is coupled to the digital cross-point matrix through a codec. As asserted above, the Examiner has not shown where *Sakurai* teaches a digital cross-point matrix or a codec configured in the manner as specifically recited within claims 3 and 7. Quite clearly, neither does *O'Malley* teach such limitations. Furthermore, *Sakurai* and *O'Malley* do not teach such claim limitations when combined. As a result, the Examiner has failed to prove a *prima facie* case of obviousness in rejecting claim 7, because important limitations are not found within any of the cited prior art references. MPEP § 2143.03 states that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As result, the Examiner has failed to prove a *prima facie* case of obviousness in rejecting claim 7.

Likewise, claim 11 is also not obvious in view of *Sakurai* and *O'Malley* for the same reasons.

The Examiner has rejected claim 22 under 35 U.S.C. § 103 as being unpatentable over *Sakurai*. As noted above, Applicants have amended claim 1 to incorporate the limitations of claim 22. The Examiner admits that *Sakurai* does not explicitly teach that the single processing means is a single microprocessor. The Examiner, though, states that combining a plurality of

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control features into one processor is old and well known in the art. Applicants respectfully traverse these assertions by the Examiner. Though it may be old and well known to combine a plurality of control features into one processor, nowhere within the prior art cited by the Examiner or within knowledge well known in the art is it taught or suggested that switching circuitry and voice processing circuitry as specifically recited within claim 1 can be controlled by a single microprocessor. None of the prior art cited by the Examiner either teaches or suggests such a possibility. Making a conclusionary statement, such as the Examiner has done, that the controlling of such switching circuitry and voice processing circuitry can be done by a single microprocessor is not obvious unless there is some suggestion within the prior art to do so. The Examiner is required to prove such a suggestion by objective evidence. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Instead of relying upon objective evidence to support the Examiner's assertion, the Examiner has merely supported such an obviousness rejection with the Examiner's own opinion, which is quite clearly not objective evidence as is required by the case law.

Furthermore, regarding the Examiner's assertion that it might be inherent to one of ordinary skill in the art to use a single microprocessor as specifically recited, the Examiner is respectfully requested to refer to MPEP § 2112, wherein it states that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). In relying upon the theory of inherency, the Examiner must provide



a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990). Applicants respectfully assert that for the Examiner to state that the controlling of the specifically recited switching circuitry and voice processing circuitry by a single microprocessor is inherent must be supported by the Examiner with objective evidence. It is insufficient for the Examiner to merely make the generalization that any two controlling functions can be accomplished by a single microprocessor.

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01; citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The Examiner's assertion that the controlling of the switching circuitry and the voice processing circuitry by a single microprocessor is insufficient to support the Examiner's *prima facie* case of obviousness. The Examiner must show where in the prior art there is a suggestion for the desirability for such a combination. The Examiner has failed to show this. This also quite clearly overcomes the Examiner's only assertion (opinion) as to why the modification is motivated within the prior art. This opinion by the Examiner is stated as "the modification clearly can save space for equipping a plurality of control elements in the system." (*Emphasis added*). Clearly, such an assertion/opinion by the Examiner is in direct contrast to the specific direction given by MPEP § 2143.01, which states that the mere fact that references can be combined or modified does not render the resultant combination obvious.

Yet still further, Applicants respectfully request the Examiner to refer to the attached Declaration Under 37 C.F.R. § 1.132 by Mr. Eric Suder, President of the Assignee of the above-identified Application. In the Declaration, Mr. Suder provides facts as to how the invention specifically recited within amended claim 1 has achieved significant commercial success. The IVX System noted in the Declaration embodies a telephone call and voice



processing system having switching circuitry and voice processing circuitry as specifically recited within claim 1, which are controlled by a single microprocessor. As a result, Applicants have demonstrated that the Declaration, and the objective evidence therein, is commensurate in scope with amended claim 1. MPEP § 716.03(a). Furthermore, the Declaration recites that the IVX System's commercial success is derived from its ability to provide control of the switching circuitry and the voice processing circuitry with a single microprocessor, including many other features that are possible under the control of such a single microprocessor. MPEP § 716.03(b).

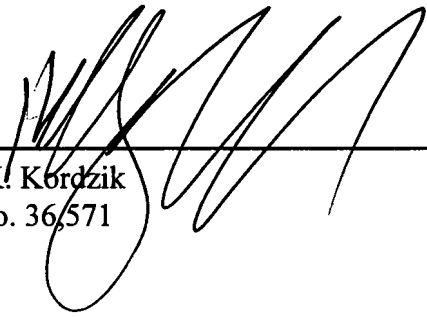
As a result, Applicants respectfully assert that the Declaration further shows how the invention specifically recited within amended claim 1 is not obvious in view of *Sakurai*.

V. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the remaining Claims in the Application are in condition for allowance, and respectfully request an early allowance of such Claims.

Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,  
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